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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,955	02/16/2001	Martina Wicher	421 P 037	5781
26568	7590	04/05/2004	EXAMINER	
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD SUITE 2850 200 WEST ADAMS STREET CHICAGO, IL 60606			KRUER, KEVIN R	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/785,955	Applicant(s) WICHER ET AL.	
	Examiner Kevin R Kruer	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,10-18 and 20-25 is/are pending in the application.
4a) Of the above claim(s) 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,10,11,15-18 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

1. Claims 12-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 09/11/2002.

Claim Rejections - 35 USC § 112

2. The rejection of claims 1-6, 8, 10, 11, 15-18, and 20-25 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been overcome. One of ordinary skill in the art would be able to understand the metes and bounds of the terms "less than about," "at least about," and "a maximum of about."

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1, 2, 4, 15, 16, 18, 21, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naydowski et al (US 5,605,568) in view of Schiappa et al (US 4,729,928) for reasons of record.
5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Naydowski et al (US 5,605,568) in view of Schiappa et al (US 4,729,928), as applied to claims 1, 2, 4, 15, 16, 18, 21, and 23-25 above, and further in view of Govers et al (US 6,482,581B1) for reasons of record.

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6. Claims 6, 8, 11, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naydowski et al (US 5,605,568) in view of Schiappa et al (US 4,729,928), as applied to claims 1, 2, 4, 15, 16, 18, 21, and 23-25 above, and further in view of Viratanen (US 6,143,064) for reasons of record.

7. Claims 1-3, 8, 10, 15-17, 21, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiorns et al (US 6,284,034) in view of Schiappa et al (US 4,729,928) for reasons of record.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hiorns et al (US 6,284,034) in view of Schiappa et al (US 4,729,928), as applied to claims 1-3, 8, 10, 15-17, 21, and 23-25 above, and further in view of Govers et al (US 6,482,581B1) for reasons of record.

9. Claims 6, 8, 11, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiorns et al (US 6,284,034) in view of Schiappa et al (US 4,729,928), as applied to claims 1-3, 8, 10, 15-17, 21, and 23-25 above, and further in view of Viratanen (US 6,143,064) for reasons of record.

10. Claims 1, 2, 4, 11, 15, 16, 18, 21, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strauch et al (US 4,279,661) in view of Schiappa et al (US 4,729,928) for reasons of record.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Strauch (US 4,279,661) in view of Schiappa et al (US 4,729,928), as applied to claims 1, 2, 4, 11, 15, 16, 18, 21, and 23-25 above, and further in view of Govers et al (US 6,482,581B1) for reasons of record.

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12. Claims 6, 8, 11, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strauch et al (US 4,279,661) in view of Schiappa et al (US 4,729,928), as applied to claims 1, 2, 4, 11, 15, 16, 18, 21, and 23-25 above, and further in view of Viratanen (US 6,143,064) for reasons of record.

13. Claims 3, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strauch et al (US 4,279,661) in view of Schiappa et al (US 4,729,928), as applied to claims 1, 2, 4, 11, 15, 16, 18, 21, and 23-25 above, and further in view of Ferris (US 3,661,610) for reasons of record.

Response to Arguments

Applicant's arguments filed January 2, 2004 have been fully considered but they are not persuasive.

With respect to Naydowski in view of Schiappa, Applicant argues that Naydowski does not teach a polyolefin coating should be applied to the pigment coating. The examiner agrees but notes that Naydowski was never relied upon for such a teaching. Rather, Schiappa was relied upon to teach the desirability of a polyolefin coating. Applicant further argues that Schiappa does not teach the claimed particle size distribution. However, Schiappa was never relied upon for such a teaching. Naydowski was relied upon to teach the claimed particle size distribution. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Moreover, Applicant argues that Naydowski simply teaches an average statistical particle diameter of 0.4 to 1.5 μ m. In contrast, the pigment coating of the present claimed invention contains at least 5% particles with a narrow grain distribution with about 70% of the particles having a size of less than about 1 μ m, and at least 40% of the particles having a grain size of 0.35 to 0.8 μ m. Naydowski teaches that the pigments should have an average particle size of 0.4-1.5 μ m (abstract), wherein 27-75wt% of the particles have a particle size or less than 1 μ m (which overlaps applicant's claimed range). Furthermore, Naydowski teaches that 0.1-35wt% of the particles have a particle size less than 0.2 μ m (col 3, lines 47+). Thus, the majority of particles have a particle size between 1 μ m and 0.2 μ m. While Naydowski does not explicitly disclose the exact particle size distribution ranges specified in the instant claims, the distribution disclosed by Naydowski overlaps with the claimed distribution and is therefore considered to necessarily meet the claim limitations. Furthermore, one skilled in the art would have found it obvious to adjust the particle size distribution of the pigment taught in Naydowski to meet the claim requirements in order to control the viscosity of the composition so that it could be applied at high coating speeds (col 8, lines 41+).

Applicant argues that such arguments "fail" because the invention of Naydowski and those in the present invention are entirely different. Furthermore, Applicant argues that the coating of Schiappa and the claimed coating of the present invention have entirely different purposes. However, it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant (see MPEP 2144).

Applicant argues that Schiappa is drawn to an ethylene acrylic acid/NMP mixture. While the examiner agrees that the thrust of Schiappa's invention is drawn to said blend, the examiner reminds applicant that a reference can be relied upon for all that it discloses. In the present situation, Schiappa teaches that polyethylene may be applied over a printed material to provide protection (col 5, lines 49+).

With respect to Hiorns in view of Schiappa, Hiorns teaches that component B (a particle with a larger size distribution) must be present. Applicant argues that such a bimodal pigment distribution teaches away from the claimed invention. The examiner respectfully disagrees. The claimed pigment coatings are "open" to components other than the claimed pigment with the claimed particle size distribution.

Applicant further argues that component B is present to allow for anti-blocking properties whereas the current invention desires that the synthetic resin coating does not separate from the pigment coating. While the examiner acknowledges that component B is included in the pigment coating taught in Hiorns in order to reduce blocking between stacked sheets, such a teaching does not render the combination of Hiorns and Schiappa moot. Blocking and adhesion are two separate properties that are not directly related. Thus, the "antiblocking" teaching of Hiorns does not suggest the pigment coating should not be coated.

With respect to Strauch, Applicant argues that the particle size distribution is optimized to control gloss whereas the particle size distribution of the pigment coating in the claimed invention is optimized for other reasons. The examiner agrees with applicant's assessment of the reference, but notes that the prior art does not have to

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provide the same motivation/benefit as applicant. Thus, Applicant's arguments are not persuasive.

Applicant argues that the particle size distribution taught in Viratanen is smaller than the particle sizes of the present invention. However, Viratanen was not relied upon to teach the claimed particle size. Rather, Viratanen was relied upon to motivate one of ordinary skill in the art to modify the particles taught in the various primary references in order to improve the brightness of the pigment coating. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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